

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HITOSHI WATANABE,
TETSUYA HASHIMOTO and YOSHIKAZU HARA

Appeal No. 2001-1209
Application 09/106,281

ORDER REMANDING TO EXAMINER

An examination of the file reveals that an Examiner's Answer was mailed December 1, 2000 (Paper No. 14) which listed JP 08-090747 as prior art. An English translation of this reference is requested. Pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy:

Experience at the Board of Patent Appeals and Interferences indicates that consideration of an English language version of the underlying document instead of the abstract aids in the resolution of patentability issues raised in an appeal. Many cases would not have gone to appeal had the examiner

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obtained the full text of the underlying document and any needed translation and considered the patentability of the claims in light of the fuller set of facts.

All participants in an appeal conference should review the appealed rejections to ensure that if an abstract is relied upon as evidence to support the rejection, the full text document and any needed translation has been obtained and considered. It should be a rare occurrence that an Examiner's Answer is prepared where a rejection is based upon an abstract rather than the underlying document.

In addition, an amendment was filed by appellant on November 15, 1999 (Paper No. 6) which requested cancellation of claim 1, and amendment to claims 2, 3, and 5 through 8. It appears that this amendment was partially entered in that the amendment to claim 5 was not physically entered into the record. Clarification regarding the status of the amendment to claim 5 is required.

Accordingly, it is

ORDERED that the application is remanded to the Examiner:

1. for providing a certified English language translation for the Japanese reference to Masaru, JP 08-090747, dated September 1996;

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2. for notifying appellant regarding the status of the amendment to claim 5, which was included in the amendment filed November 15, 1999 (Paper No. 6). (If the amendment to claim 5 is entered, physical entry into the record is required. Appellant should be notified to submit a new Appendix to the Appeal Brief which includes a correct copy of claim 5, or the Examiner will need to issue a supplemental Examiner's Answer which contains a correct copy of the claim 5); and

3. for such further action as may be appropriate.

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By: _____
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